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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/578,993

05/11/2006

Eugene Sherry

5000-061503

5104

28289 7590 06/27/2007

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EXAMINER

COHEN, AMY R

ART UNIT

PAPER NUMBER

2859

MAIL DATE

DELIVERY MODE

06/27/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/578,993	Applicant(s) SHERRY ET AL.	
	Examiner Amy R. Cohen	Art Unit 2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 16-30 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 16-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Von Arx (U. S. Patent No. 2,554,133).

Von Arx teaches a gauge (10) to determine a first angle in a first plane and a second angle in a second plane, said gauge comprising: a body (12); and a plumb bob (54) mounted to said body so as to hang under the influence of a local gravitational field, said plumb bob being rotatable relative to said body in both said first plane and said second plane so as to determine said first angle and said second angle respectively (Fig. 2, Col 2, lines 14-41).

Von Arx teaches the gauge wherein a universal joint rotatably mounts said plumb bob to said body (Fig. 2, Col 2, lines 14-41).

Von Arx teaches the gauge wherein said universal joint is any one of: a ball joint; a singular pivot-pivot joint; an eye joint; a tie rod end joint; or a rose joint (Fig. 2, Col 2, lines 14-41).

Von Arx teaches the gauge wherein said first plane is orthogonal to said second plane (Col 1, lines 1-26).

Von Arx teaches the gauge wherein said plumb bob includes a pointer (70) (Fig. 2, Col 2, lines 42-50).

Von Arx teaches the gauge wherein said body includes markings (64) disposed adjacent said marker (Fig. 4, Col 2, lines 42-50).

Regarding claim 16, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987). See MPEP 2106 and 2111.04. In this case this intended use is considered to be for use in a surgical procedure.

3. Claims 16 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Afromowitz (U. S. Patent No. 4,627,172).

Afromowitz teaches a gauge (10) to determine a first angle in a first plane and a second angle in a second plane, said gauge comprising: a body (11); and a plumb bob (22) mounted to said body so as to hang under the influence of a local gravitational field, said plumb bob being rotatable relative to said body in both said first plane and said second plane so as to determine said first angle and said second angle respectively (Figs. 1-3, Col 1, lines 10-15, Col 2, lines 20-26).

Afromowitz teaches the gauge wherein movement of the plumb bob relative to the body is damped (Col 1, lines 18-21, Col 6, lines 56-64).

Regarding claim 16, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d

1647 (1987). See MPEP 2106 and 2111.04. In this case this intended use is considered to be for use in a surgical procedure.

4. Claims 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Levvero (U. S. Patent No. 2,627,666).

Levrero teaches a gauge (Figs. 1-4) to determine a first angle in a first plane and a second angle in a second plane, said gauge comprising: a body (1); a first plumb bob (7) mounted to said body so as to hang under the influence of a local gravitational field, said first plumb bob being rotatable relative to said body in said first plane so as to determine said first angle (Figs. 1-4, Col 2, lines 27-50); and a second plumb bob (15) mounted to said body so as to hang under the influence of a local gravitational field, said second plumb bob being rotatable relative to said body in said second plane so as to determine said second angle (Figs. 1-4, Col 3, lines 1-22).

Levrero teaches the gauge wherein said first plumb bob is mounted to said body for rotation about a first axis and the second plumb bob is mounted to said body for rotation about a second axis, whereby said first axis is orthogonal to said second axis (Figs. 1-4, Col 3, lines 12-39).

Regarding claim 29, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). See MPEP 2106 and 2111.04. In this case this intended use is considered to be for use in a surgical procedure.

5. Claims 16-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Augustino et al. (U. S. Patent No. 7,051,451).

Augustino et al. teaches a gauge (700, 800) for use in a surgical procedure to determine a first angle in a first plane and a second angle in a second plane, said gauge comprising: a body (800); and a plumb bob (701) mounted to said body so as to hang under the influence of a local gravitational field, said plumb bob being rotatable relative to said body in both said first plane and said second plane so as to determine said first angle and said second angle respectively (Figs. 8A-9D, Col 4, lines 30-56, Col 8, lines 26-62).

Augustino et al. teaches the gauge wherein a universal joint rotatably mounts said plumb bob to said body (Figs. 8A-9D, Col 8, lines 26-62).

Augustino et al. teaches the gauge wherein said universal joint is any one of: a ball joint; a singular pivot-pivot joint; an eye joint; a tie rod end joint; or a rose joint (Figs. 8A-9D, Col 8, lines 26-37, lines 46-51).

Augustino et al. teaches the gauge wherein said first plane is orthogonal to said second plane (Figs. 8A-9D, Col 8, lines 26-62).

Augustino et al. teaches the gauge wherein said plumb bob includes a pointer (701) (Figs. 8A-9D, Col 8, lines 26-62, Col 9, lines 8-41, Col 10, lines 12-35).

Augustino et al. teaches the gauge wherein said body includes markings disposed adjacent said pointer (Figs. 8A-9D, Col 9, lines 8-41, Col 10, lines 12-35).

Augustino et al. teaches the gauge wherein a first sub-set of said markings corresponds to angular increments of said first angle and a second sub-set of said markings corresponds to angular increments of said second angle (Figs. 8A-9D, Col 9, lines 8-41, Col 10, lines 12-35).

Augustino et al. teaches the gauge including a connector disposed on said body for connection of said gauge to a prosthetic component (Col 4, lines 30-56, Col 8, lines 37-62, Col 9, lines 42-52).

Augustino et al. teaches the gauge including a connector disposed on said body for connection of said gauge to a predefined site of a patient (Col 4, lines 30-56, Col 8, lines 37-62, Col 9, lines 42-52).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 16, 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farmer et al. (U. S. Patent No. 5,141,512) in view of Augustino et al.

Farmer et al. discloses a gauge for use in a surgical procedure to determine a first angle in a first plane and a second angle in a second plane (Col 1, lines 1-16), said gauge comprising a body (10); wherein said surgical procedure is the insertion of an acetabular cup into a reamed acetabulum during hip replacement surgery (Col 1, lines 1-16, Col 2, lines 4-55); wherein said first angle corresponds to an aversion of said acetabular cup relative to the reamed acetabulum (Col 3, lines 52-64, Col 6, lines 32-58, Col 11, lines 1-38); wherein said second angle corresponds to an abduction of said acetabular cup relative to the reamed acetabulum (Col 3, lines 52-64, Col 6, lines 32-58, Col 11, lines 1-38).

Farmer et al. does not disclose the gauge comprising a plumb bob mounted to said body so as to hang under the influence of a local gravitational field, said plumb bob being rotatable relative to said body in both said first plane and said second plane so as to determine said first angle and said second angle respectively.

Augustino et al. discloses a gauge (700, 800) for use in a surgical procedure to determine a first angle in a first plane and a second angle in a second plane, said gauge comprising: a body (800); and a plumb bob (701) mounted to said body so as to hang under the influence of a local gravitational field, said plumb bob being rotatable relative to said body in both said first plane and said second plane so as to determine said first angle and said second angle respectively (Figs. 8A-9D, Col 4, lines 30-56, Col 8, lines 26-62).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the gauge of Farmer et al. be a plumb bob, as taught by Augustino et al., in order to simplify the device, decreasing parts and decreasing the cost of parts, thereby decreasing the overall cost of the gauge.

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).



Art Unit: 2859

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 16-30 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 161-193 of copending Application No.

10/494085. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to a gauge for use in a surgical procedure comprising a plumb bob wherein the surgical procedure is a hip replacement surgery.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following disclose gauges Saenger et al. (U. S. Patent No. 6,361,506), Lee (U. S. Patent No. 6,049,989), and Cook (U. S. Patent No. 1,409,833).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy R. Cohen whose telephone number is (571) 272-2238. The examiner can normally be reached on 8 am - 5 pm, M-F.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F. Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2859

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ARC

June 21, 2007

  
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PRIMARY EXAMINER  
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